REMARKS

With the above amendments, claims 9-25 have been canceled, claims 34-38 have been added, claims 1-8 and 26-38 are pending with claims 26-29 having been withdrawn from a prior restriction requirement, and claims 1-8 and 30-38 are ready for further action on the merits. No new matter has been incorporated. New claims 34-38 come from claims 1, 3, and 28-30 except differ in that they do not contain the proviso "wherein said protein or said peptide does not cleave plasminogen kringle".

Rejections under 35 USC §112, first paragraph

Claims 1, 3-6 and 30-33 have been rejected under 35 USC §112, first paragraph as allegedly lacking description. This rejection is traversed for the following reasons. The Examiner asserts that because there is no "explicit" support for the element added to these claims, i.e. "wherein said protein or said peptide does not cleave plasminogen kringle" that this constitutes new matter. The Applicants must respectfully disagree. The Applicants are citing a property of the enzyme that it inherently lacks. As was pointed out in the response of January 19, 2001, the case law is well established in this area where a compound (i.e. a protein) has been well characterized. It does not constitute new matter to add an inherent property of that compound to a claim. See In re Magerlein and Schneider, 145 USPQ 683 (CCPA, 1965) citing In re

Nathan, 140 USPQ 601, 603 (CCPA, 1964). The Federal Circuit, more recently, has also allowed the addition of an inherent property to a claim wherein that property was not explicitly present in the specification. See Kennecott Corp. v. Kyocera International Inc., 5 USPQ2d 1194 (Fed. Cir., 1987). Thus, the rejection is inappropriate.

Further, the Applicants have submitted a 37 CFR §1.132 declaration certifying that the element, "wherein said protein or said peptide does not cleave plasminogen kringle" (i.e. it inherently lacks proteolytic activity) is an inherent property of the enzyme. The Applicants have thus provided extrinsic evidence that this is indeed an inherent property of this enzyme. Withdrawal of the rejection is not only warranted, it is also respectfully requested.

Rejections under 35 USC §102

Claim 7 has been rejected under 35 USC §102(b) as being anticipated by Reed '572 (US Patent No. 5,916,572). This rejection is strenuously traversed for the following reasons. The Examiner asserts that Reed '572 teaches five contiguous amino acid residues with SEQ ID NO: 2 that are capable of binding the N-terminal fragment of plaminogen. The Applicants vigorously but respectfully disagree. The Applicants do acknowledge that Reed '572 may teach five contiguous amino acids that are in common with

the claimed SEQ ID NO: 2 of the instant invention. However, claim 7 is not just limited to five contiguous amino acids. There is also the element that it be capable of binding an N-terminal fragment of plasminogen.

The Examiner is reminded that for a reference to anticipate a claim, it must teach every element of the claim (see *Verdegaal Bros.*, 2 USPQ2d 1913, 1920 (Fed. Cir., 1989). Nowhere in Reed '572 is plasminogen even mentioned. Simply showing that Reed has 5 contiguous amino acids with SEQ ID NO: 2 is not sufficient to show that it also binds an N-terminal region of plasminogen.

The Applicants fail to see how the Examiner can assert that the polypeptides disclosed in Reed '572 bind the N-terminal region of plasminogen. Accordingly, this rejection is inapposite. Withdrawal of the rejection is respectfully requested.

The Applicants believe that claims 34-38 are patentable and should not be rejected under 35 USC §102(b) as anticipated by Petersen et al. (J. Biol. Chem., 265(11), pp. 6104-6111, (1990)) for the following reasons. The Examiner asserts that Peterson et al. disclose that Fibrin acts as an angiogenesis-associated protein that binds an N-terminal fragment of fibrinogen.

Again, the Examiner is reminded that for a reference to anticipate a claim, it must teach every element of the claim (see *Verdegaal Bros.*, 2 USPQ2d 1913, 1920 (Fed. Cir., 1989). Claims 34-38 recite the element, an "isolated human protein having anti-

angiogenic activity . . .". The Applicants do not dispute that Petersen et al. disclose that the first and the second kringle domains in plasminogen are a putative binding site for plasminogen. However, the Applicants do dispute any assertion that Fibrin has anti-angiogenic activity. To the Applicants knowledge, there is no published evidence that fibrin has anti-angiogenic activity.

Further, the Applicants do not believe that there has ever been a report that fibrin has any effect on angiogenesis. Absent some proof that Fibrin has anti-angiogenic activity, any putative rejection is baseless.

Accordingly, with the above remarks and amendments, it is believed that the claims, as they now stand, define patentable subject matter such that a passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited. Further, it is respectfully requested that the method of use claims also be allowed.

If any questions remain regarding the above matters, please contact Applicant's representative, Gerald M. Murphy, in the Washington metropolitan area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By _____ #32,868

for Gerald M. Murphy, Jr. #28,977

GMM/TBS/crt

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000